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EXAMINER

PHILOGENE, PEDRO

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/807,999
Filing Date: March 24, 2004
Appellant(s): FALAHEE, MARK H.

John G. Posa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/28/05 appealing from the Office action mailed 4/26/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 9/28/05 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,648,388	Steffee	3-1987
324,768	Hunt	8-1885

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 8, 9, and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Steffee (U.S. Patent No. 4,648,388).

Steffee discloses a system comprising a bone anchor 52, e.g. screw, having a proximal and distal ends and an outer sidewall. The system also includes a connector or elbow having a portion that engages with the bone anchor 52 and an arm that engages an stabilizing rod 30 (see Figures 1-6). The proximal end of the bone anchor is positionable near or at a surface of a bone. The rod is positioned transverse to the arm (see for example Figure 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steffee (U.S. Patent No. 4,648,388) in view of Hunt (U.S. Patent 324,768).

Steeffee discloses the claimed invention except for the anchor including outwardly tangs or barbs. Hunt teaches to provide screws with an outwardly tang or barb in order to lock the screw after it has been screw home (see page 1, lines 12-14). It would have been obvious to one skill in the art at the time the invention was made to construct the system of Steffee with the anchor, i.e. screw, having an outwardly tang or barb in view of Hunt, in order to lock the screw in position thus preventing that it is removed. With regard to the tang or barb are tangs or barbs, it is noted that it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

(10) Response to Argument

Applicant's arguments filed on 2/4/05 have been fully considered but they are not persuasive.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In *re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In *re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In *re Bozek*, 163 USPQ 545 (CCPA) 1969. In this case, Steffee discloses the claimed invention except for the anchor, i.e. a screw, including outwardly tangs or barbs and Hunt teaches a screw with an outwardly tang or barb. Hunt further disclose that the purpose of providing a screw with tangs or bards is to lock the screw after it has been screw home (see page 1, lines 12-14). Thus, clearly Hunt provides enough suggestion and motivation for one skill in the art to provide another screw, e.g. the screw of Steffee, with tangs or barbs in view of Hunt, in order to lock the screw in position, i.e. home, and thus preventing that it is removed.

In response to Applicant's argument that Stefee and Hunt are nonanalogous art, it has been held that the determination that a reference is from a nonanalogous art is twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. In *re Wood*, 202 USPQ 171,

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174. In this case, the references are within the field of the inventor's endeavor, e.g. screws and clamps and rods, and Steffee and Hunt are related to the field of screws and how they are designed to function to attach and be attached to other structures. Furthermore, the issue of providing tangs or barbs to a screw to assist with fixation is a problem clearly related to the Hunt reference which clearly teaches that to provide a screw with tangs or barbs is old and well known in the art for the purposes of fixing the screw in place, as Hunt called it , to lock the screw after it has been screw home.

In response to applicant's argument that he does not understand how Steffee reads on the limitation "wherein the proximal end of the bone anchor is at or near the surface of a bone once in position", it is noted that this is just functional language, it is a step of how the anchor is intended to be used. It is noted that **the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations**. Ex parte Masham, 2 USPQ2d 1647 (1987). In the current case the reference(s) show all the structural limitations.

In response to applicant's argument that Steffee does not show an elbow, it is noted that Steffee clearly shows what can be considered an elbow, e.g. part 104.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Pedro Philogene/

Primary Examiner

December 01, 2005

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